

**Remarks:**

Applicant has carefully studied the nonfinal Examiner's Action mailed 09/29/2003, and all references cited therein. The amendment appearing above and these explanatory remarks are believed to be fully responsive to the Action. Accordingly, this important patent application is now believed to be in condition for allowance.

This Amendment is entitled Amendment D because the Preliminary Amendment filed with the Request For Continued Examination was the third (C) amendment filed in this case.

Applicant responds to the outstanding Action by centered headings and numbered paragraphs that correspond to the centered headings and paragraph numbering employed by the Office, to ensure full response on the merits to each finding of the Office.

***Specification***

The Preliminary Amendment filed July 23, 2003 stands objected to under 35 U.S.C. § 132 because it introduces new matter into the disclosure.

Specifically, the term "cushioning material to absorb kinetic energy" is not supported in the original disclosure. Upon reviewing the disclosure as filed, it is noted that cylinder 20 is disclosed in paragraph [0017], lines 6-7, as "constructed of substantially resilient foam material. This material is preferably low density polyethylene foam." In paragraph [0035], line 2, it is referred to as a "low density polyethylene foam cylinder 20." In paragraph [0036], at line 11, cylinder 20 is said to formed of a "soft foam material."

Therefore, the Office is being quite literal in its view that "cushioning material" is new matter in view of the original disclosure of "substantially resilient foam material," "low density polyethylene foam," and "soft foam material." The expression "to absorb kinetic energy" is purely explanatory and functional and does not constitute structural new matter, *i.e.*, the observation that "substantially resilient foam material," "low density polyethylene foam," and "soft foam material" will absorb kinetic energy when struck is an inherent feature of such material. Thus, it is not new matter to re-name a substantially resilient soft foam material as a cushioning material and to point out that such material absorbs kinetic energy when struck.

The Office further argues: "The device cannot absorb if it is detachable when hit." To the contrary, when a substantially resilient soft foam material is hit, it begins to absorb kinetic energy as soon as the deformation begins. Applicant did not state that cylinder 20 absorbs all of the kinetic energy without being knocked from its holder. Applicant merely implied that at least

some kinetic energy is depleted by the time cylinder 20 is separated from its holder. This is a mere observation as to the effects a structure has, and does not constitute new structure. The purpose of the rule against the introduction of new matter is to prevent an inventor from injecting into a patent application structure that was not present when the application was filed. Thus, functional statements or well-known scientific principles, if introduced after the filing date, are merely explanatory comments that do not inject new structure or new matter into a patent application.

Applicant, in view of this unusually lengthy prosecution, has nonetheless removed all reference to a cushioning material that absorbs kinetic energy and has reverted to the soft foam material language to overcome this ground of rejection. As amended, the application no longer recites that such material absorbs kinetic energy, but those of ordinary skill in the art will understand its function and will further appreciate that when the soft foam material has exhausted its capacity to absorb kinetic energy, the absorption of kinetic energy takes the form of detachment of cylinder 20 from its holder. Thus it is understood that the mere fact of detachment does not prove that no kinetic energy was absorbed prior to such detachment as the Office asserts ("The device cannot absorb if it is detachable when hit.") Applicant therefore assumes that the Office meant to say that the device does not absorb all of the kinetic energy if it is detachable when hit, and the Office should understand that Applicant meant to say that the cushioning material absorbs at least some kinetic energy before detaching.

The Office further considers as new matter Applicant's comment: "It is not feasible to list all known releasable fasteners such as snaps and buckles, quick release clamps..." because such comment "appears to add more specific attachment alternatives." It is obvious that the term "releasable fasteners" includes a multitude of well-known structures and for a patent applicant to add to a patent application the obvious observation that said term includes too many alternative structures to list should not be deemed to introduce "more specific attachment alternatives." The language has been removed in view of this lengthy prosecution but Applicant cautions potential infringers that the substitution of any well-known releasable fastening means for the structure depicted in the drawings of this application will be deemed by the courts to infringe the claims appended hereto because the term "releasable fasteners" covers a multitude of devices even though the patent to be awarded does not expressly recite such fact.

*Claim Rejections – 35 U.S.C. § 112*

Applicant acknowledges the quotation of 35 U.S.C. § 112, first paragraph.

2. Claims 14-21 stand rejected under 35 U.S.C. § 112, first paragraph, because claim 14 recites a cushioning material to absorb kinetic energy and that the structure is hollow. The Office contends that said claim is not supported by the original disclosure. Specifically, the Office contends: "The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." This ground of rejection as it relates to claim 14 has been rendered moot by the cancellation of the purported new matter from said claim. Applicant admits that the application as filed does not expressly state that the structures are hollow but Figure 7 and the accompanying description concerning the guide cords does recite at paragraph [0038], lines 7-8: "It is preferred that the assembly guide cord be threadedly received through each of the disengageable members..." Figure 7 clearly depicts the assembly guide cords positioned in the respective lumens of the disengageable members so under any fair and balanced interpretation of the statutory language the description and Figure 7 "reasonably convey to one skilled in the relevant art" that said members are hollow. Only a conservative construction of what it means to "reasonably convey to one skilled in the relevant art" could support a conclusion that it is new matter to point out that said members are hollow. The statute does not require a patent applicant to literally or explicitly convey information to one skilled in the relevant art. The skill referred to in the statute creates a presumption that one skilled in the art need not be told even the most obvious facts. Would one skilled in the art fail in the attempt to make Applicant's invention, using only Applicant's disclosure as the instruction manual, because he or she used solid disengageable members and was therefore unable to thread an elongate guide cord therethrough? Applicant has removed the offending word "hollow" from the claims only because this prosecution has already been lengthy and not because Figure 7 as filed and the accompanying description would have failed to reasonably convey the hollowness of the disengageable members in view of Applicant's failure to expressly use that word in the initial description. The same observation applies to Applicant's initial use of "student" and "lower handicap" and "tour players" and his subsequent use of "first skill level" and "second skill level." The terms "first skill level" and "second skill level" are clearly generic terms intended to convey meaning to those who do not know about handicaps and what a tour player is.

Thus, such "new matter" terms are intended to reasonably convey information to those who lack ordinary skill in the field and certainly would not be considered new matter by one of ordinary skill in the field of the game of golf. Again, Applicant removes the offending terms to speed up the prosecution of this case and not because the law requires such removal. The Office's contention that it is new matter to introduce the term "post" where the original disclosure is "vertical extension" or "horizontal extension" or "support arm" is astute and Applicant thanks the Office for pointing out the new matter included in the use of that misdescriptive term. A post is typically of solid construction and said term therefore contradicts the initial disclosure and is removed from the specification and claims by this amendment.

Applicant acknowledges the quotation of 35 U.S.C. § 112, second paragraph.

3. Claims 14-21 stand rejected under 35 U.S.C. § 112, second paragraph, because claim 14 recites a third post having a first and a second position where said positions are not clearly defined. The post has two free ends so it is ambiguous to recite that one end is closer to the golf target and the other end is away from the golf target in any particular arrangement because that is true of either arrangement. This astute observation has been remedied by amending claim 14 to recite that in a first configuration the support arm is in trailing relation to the cradle interface, relative to the target hole, and in a second configuration the support arm is in leading relation to the cradle interface, relative to the target hole. Applicant thanks the Office for its astute interpretation of the ambiguous claim language.

***Claim Rejections – 35 U.S.C. § 103***

Applicant acknowledges the quotation of 35 U.S.C. § 103(a).

4. Claims 14 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Marier, Jr. in view of Wateska et al. (hereinafter "Wateska"); reconsideration and withdrawal of this ground of rejection is requested. The Office contends:

The elevated path guide means are two cylindrical rods in (*sic*) which separate from the device upon impact of a club and it is noted that the elevated path guide means may also be one continuous rod (See Column 2, lines 23 through 59)...

Though Marier, Jr. prefers the elevated path guide means to extend in two directions, it is capable of achieving the same result with one rod extending in one direction. It is also clearly apparent that the rods can be reversibly engaged.

What Marier, Jr. "prefers" is of no legal significance. The issue, of course, is what does Marier, Jr., teach or suggest to one of ordinary skill when considered in conjunction with the prior art as a whole? If rods 22 are formed by a continuous shaft, that continuous shaft is engaged at its mid-section. All of the Marier, Jr. drawings and all of the Marier, Jr. text teaches that there are either two (2) rods 22 joined at their respective ends to T-joint 24 or that said T-joint can engage a single rod in the same way. There is no teaching or suggestion whatsoever that one of the rods 22 can be excised from the corpus of the invention, and that the sole remaining rod could then be placed on the trailing side of T-joint 24 for student golfers or on the leading side of said T-joint 24 for advanced golfers. Only Applicant teaches a single rod that is positioned on the trailing side of the cradle interface for students and on the leading side of said cradle interface for advanced golfers.

Nor is it new matter to define the configuration of Fig. 5 as a trailing configuration and the configuration of Fig. 6 as a leading configuration. That terminology is used because the concepts of trailing and leading are well understood and as the Office astutely pointed out, the terminology initially used is ambiguous. The invention has not changed nor has anything new been added to it by simply describing the respective configurations of Figures 5 and 6 in a well-known, broadly understood way.

As amended, claim 14 is no longer ambiguous as to how Applicant's support arm is mounted. It is positioned so that the support arm is on the trailing side of the cradle interface, relative to a target hole, for student players and the support arm is on the leading side of the cradle interface, relative to the target hole, for advanced players. Marier, Jr., contains no suggestion or teaching that rod or rods 22 should be placed on a trailing or a leading side of the T-joint, dependant upon whether the device is being used by a student or an advanced player, respectively. Such skill level-dependent alternative placement is Applicant's contribution to the art and Applicant is entitled to the *quid pro quo* promised to those who advance the useful arts. The addition of a soft foam material to Applicant's support arm, even if suggested by Wateska, does not teach or suggest the subject matter of claim 14, currently amended.

5. Claims 15 and 17 stand rejected under 35 U.S.C. § 112 as being unpatentable over the prior art as applied to claim 14, in view of Macri. Applicant acknowledges that Macri and the admitted prior art would have suggested the respective subjects matter of claims 15 and 17.

Applicant relies upon the dependency of claims 15 and 17 from claim 14 to support their allowance. Neither Macri nor the admitted prior art would have taught or suggested the invention claimed in claim 14, as currently amended.

6. Claim 18 stands rejected under 35 U.S.C. § 112 as being unpatentable over the prior art as applied to claim 14, in view of McCormick. Applicant acknowledges that McCormick and the admitted prior art would have suggested the subject matter of claim 18. Applicant relies upon the dependency of claim 18 from claim 14 to support its allowance. Neither McCormick nor the admitted prior art would have taught or suggested the invention claimed in claim 14, as currently amended.

7. Claims 19 and 20 stand rejected under 35 U.S.C. § 112 as being unpatentable over the prior art as applied to claim 14. Applicant acknowledges that the admitted prior art would have suggested the respective subjects matter of claims 19 and 20. Applicant relies upon the dependency of claims 19 and 20 from claim 14 to support their allowance. The admitted prior art would not have taught or suggested the invention claimed in claim 14, as currently amended.

8. Claim 21 stands rejected under 35 U.S.C. § 112 as being unpatentable over the prior art as applied to claim 20, further in view of Lambert. Applicant acknowledges that Lambert and the admitted prior art would have suggested the subject matter of claim 21. Applicant relies upon the dependency of claim 21 from claim 14 to support its allowance. Neither Lambert nor the admitted prior art would have taught or suggested the invention claimed in claim 14, as currently amended.

#### *Response to Arguments*

Applicant does not understand why the arguments with respect to claims 1-13 have been considered but are rendered moot in view of the new grounds of rejection. Said claims were cancelled in Amendment C. Applicant assumes the Office meant to refer to claims 14-21 and Applicant acknowledges that Applicant's arguments with respect to claims 14-21 have been considered but rendered moot in view of the new grounds of rejection (Wateska) which was not cited as a reference in earlier Office Actions.

#### *Conclusion*

If the Office is not fully persuaded as to the merits of Applicant's position, or if an Examiner's Amendment would place the pending claims in condition for allowance, a telephone call to the undersigned at (727) 507-8558 is requested. Applicant thanks the Office for its careful